IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s): Jose A. Tierno
Docket No.: YOR920030375US1
Serial No.: 10/668,562
Filing Date: September 23, 2003
Group: 2611
Examiner: Leila Malek

Title: Methods and Apparatus For Snapshot-Based Equalization of a Communications Channel

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REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The remarks which follow are submitted in response to the Examiner's Answer dated August 4, 2009 in the above-identified application. The arguments presented by Appellant in the corresponding Appeal Brief are hereby incorporated by reference herein.

In the Answer at pages 10-16, the Examiner responds to various arguments raised by Appellant in the Appeal Brief.

REMARKS

On page 12, last paragraph, of the Answer, the Examiner argues that Yada supplements the admitted failure of Ariyavisitakul to teach or suggest "generating at least one sampling from the received input signal based on a clock signal unrelated to a clock signal used to recover data associated with the received input signal," as recited in claim 1. Appellant notes that claim 1 requires that the clock signal that is the basis of generating at least one sampling be unrelated to a clock signal used to recover data, not merely that different clocks be used or that the clock signals have different frequencies.

Giving "the claim (and term 'unrelated') its broadest reasonable interpretation," as the Examiner claims to have done in the Answer at page 12, last paragraph, last sentence, "means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification," as discussed in MPEP 2111.01(I) and the cases cited therein. See also *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) ("Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say."); *Merck & Co., Inc., v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1370, 73 USPQ2d 1641, 1646 (Fed. Cir. 2005) ("When a patentee acts as his own lexicographer in redefining the meaning of particular claim terms away from their ordinary meaning, he must clearly express that intent in the written description.").

In the Answer at page 12, last paragraph, the Examiner argues that because "the clock used by ADC 4 is not the clock used by data detector 6," Yada meets the limitation at issue. Appellant respectfully submits that this interpretation is inconsistent with the plain meaning of the term "unrelated," which is "not related." Unrelated items are those which are not related and hence there is no relationship between unrelated items. It is not sufficient that the two items be different or not identical. Thus, the Examiner's interpretation of "unrelated" as merely meaning "not identical" is inconsistent with the plain meaning of the word "unrelated."

The Examiner argues that the specification at page 2, lines 16-17, which states that the "sampling clock may have a lower frequency than the data recovery clock signal," is "the first

statement presented by the Applicants to show that the clocks are unrelated. Yada does not teach away from this statement, because it shows that the clock signals are not identical and therefore they may have different frequencies."

Appellant respectfully submits that this sentence of the specification does not even contain the word "unrelated" and is in fact entirely inapposite to the definition thereof. Appellant respectfully directs the Examiner's attention to the specification at, for example, page 5, lines 3-13, and page 6, lines 9-13, which utilize the term "unrelated" in connection with illustrative embodiments.

As previously noted, column 8, lines 63-68, of Yada explains that "data detector 6 [is] supplied with a clock generated by phase locked loop (PLL) circuit 7, the latter being coupled to the output of the waveform equalizer to extract a clock from the waveform equalized digitized audio signal supplied thereto." Thus, the clock used by the data detector 6 is extracted from the equalizer output signal which was sampled at the rate of clock Fs (ADC clock), and therefore the two clocks are related, even if the clock signals are not identical.

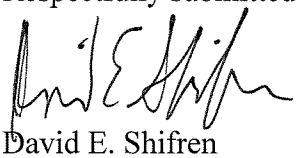
On page 14, last paragraph, the Examiner addresses Appellant's argument that Ariyavisitakul does not contain the disclosure which is necessary to support a rejection of a claim on the basis of inherency. As previously noted, in "relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy,* 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) The evidence provided by the Examiner "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Examiner, on page 14, last paragraph, of the Answer, asserts, with no further explanation or support, that "every sampling device known in the art needs to have a clock in order to function properly (sample the signal) and it is impossible to sample a signal without using a sampling clock." This conclusory statement amounts to an assessment of basic knowledge and common sense which is not based on any evidence in the record of the type deemed by the Federal Circuit to lack the

"substantial evidence" support needed to form the basis for a rejection. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Rather, the Examiner provide either documentary evidence or an affidavit or declaration setting forth specific factual statements and explanation to support the proffered statement, as required by 37 CFR 1.04(d)(2).

In view of the above, Appellant maintains that claims 1-23 are in condition for allowance, and respectfully request reversal of the pending rejections.

Respectfully submitted,



Date: October 5, 2009

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